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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,784	10/23/2003	Michel Marcel Jose Decre	NL000078A	7172

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BRIARCLIFF MANOR, NY 10510

EXAMINER

JOLLEY, KIRSTEN

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,784

Applicant(s)

DECRE, MICHEL MARCEL JOSE

Examiner

Kirsten C Jolley

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/773,131.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments/Amendments

1. The 35 USC 112, 1st paragraph rejections set forth in the prior Office action have been withdrawn in response to Applicant's deletion of the phrases "the physical properties of the coating indicate that it was formed by solidification during rotation" and "the physical properties of the coating indicate that it was separated from the extension body after the substantial solidification" from the claims. Applicant argues that these limitations are inherent. The Examiner finds this argument unconvincing since there is nothing in the specification to indicate that separation of the coating from the extension body after substantial solidification affects the physical properties of the coating.
2. The 35 USC 112, 2nd paragraph rejections set forth in the prior Office action are maintained. Applicant argues that "a few mm" is defined in the specification at page 2, lines 12-15. It is noted that the specification at page 2, lines 12-15, states "a few mm, e.g. 5 mm". The term "e.g." is short for "exempli gratia" meaning "for example." This citation in the specification is therefore not limiting and merely exemplary, and does not provide a clear definition of what is required by the phrase "a few mm." Therefore, the Examiner maintains the position that the claims are vague and indefinite because the metes and bounds of the claim are not known.
3. With respect to the 35 USC 102(e) rejections over Nishida et al., Applicant argues that Nishida does not suggest that the extension body and the substrate are separated "before the coating is fully solidified" as in the amended claims, and that the Examiner has not pointed out

Art Unit: 1762

anywhere in the citation where it is suggested that the extension body be removed before the coating is cured. First, it is noted that this newly-added limitation appears to be new matter, and is rejected under 35 USC 112, 1st paragraph below. Further, while it is acknowledged that the process of Nishida et al. does not include a step of separating the extension body and the substrate before the coating is fully solidified, it is the Examiner's position that the product produced by the two methods would be materially similar. Both processes disclose that, due to the presence of the extension body during coating, surface irregularities such as humps are avoided. It is noted that the product must be patentable on its own merits. *In re Stephens*, 145 USPQ 656. *In re Kern*, 129 USPQ 345. The patentability of a product is based on the product limitations and not on the recited process steps. *In re Brown*, 173 USPQ 685. When the prior art discloses a product which reasonably appears to be identical with or only slightly different than a product claimed in a product by process claim, a rejection based on 102/103 is appropriate. *In re Fessmann*, 180 USPQ 324. Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). Applicant has not provided any evidence to establish why the claimed product of Nishida et al. differs from that of the claimed invention.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

Art Unit: 1762

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 9-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In independent claims 9-11 and 17-18, the newly added limitation “after substantial solidification of the liquid, *and before the coating is fully solidified*, the extension body and the substrate are separated” [emphasis added] appears to be new matter. The Examiner could not locate disclosure in the specification that separation of the extension body and the substrate occurs after substantial solidification but before full solidification. If Applicant cites the location of such disclosure on the record, the Examiner will withdraw this rejection.

In claim 9, lines 16-18, the phrase “*the substantial solidification being sufficient that the substrate is substantially free from optical birefringence in a few mm broad peripheral zone*” [emphasis added] appears to be new matter. The Examiner could not locate disclosure in the specification stating that the substantial solidification is sufficient that, or is the reason that, the substrate is substantially free from optical birefringence.

In claim 10, lines 16-17, the newly added phrase “the coating being formed by substantial solidification during rotation” appears to be new matter. In contrast, it is noted that the specification states on page 6, lines 24-25 “Once the rotation has stopped, the liquid layer is solidified by exposure to UV light...”

In claim 11, the newly added limitation “the separation occurring and the curing continuing after completion of the spinning” appears to be new matter.

In claim 17, line 6, and in claim 18, lines 5-6, the phrase “fully curing the liquid to form a solid” appears to comprise new matter. There is no disclosure in the specification that the liquid is “fully” cured.

In claim 17, lines 18-20, and in claim 18, lines 17-19, the limitation “the partial curing of the liquid prior to separating the extension body being sufficient to substantially reduce a hump in the coating at the periphery” appears to be new matter. The specification does not disclose that partial curing occurring prior to separation reduces a hump.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 9, 12, and 15-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9, line 16, the phrase “in a few mm” renders the claim vague and indefinite because it is not clear what the metes and bounds of “few” are.

Claim Rejections - 35 USC § 102/103

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1762

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 9-18 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nishida et al. (US 6,349,086).

Nishida et al. discloses a circular optical disc which is substantially free from optical birefringence and irregularities such as humps in a few mm broad peripheral zone, and whereby the coating is separated from the extension body after the substantial solidification. See col. 11, lines 25-51 and Figures 12-14 of Nishida et al. It is noted that the curing of Nishida et al. performs solidification by exposure to UV light. While the process of Nishida et al. does not comprise separating the extension body and the substrate after substantial solidification of the liquid and before the coating is fully solidified, it is the Examiner's position that the resulting coated substrate would none-the-less be the same or similar because further solidification of the coating (after removing from the extension body) would not affect the properties of the final product produced.

It is noted that the product must be patentable on its own merits. *In re Stephens*, 145 USPQ 656. *In re Kern*, 129 USPQ 345. The patentability of a product is based on the product limitations and not on the recited process steps. *In re Brown*, 173 USPQ 685. When the prior art

Art Unit: 1762

discloses a product which reasonably appears to be identical with or only slightly different than a product claimed in a product by process claim, a rejection based on 102/103 is appropriate. *In re Fessmann*, 180 USPQ 324. Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1762

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C Jolley whose telephone number is 571-272-1421. The examiner can normally be reached on Monday to Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on 571-272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kirsten C Jolley
Primary Examiner
Art Unit 1762

kcj